The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

**Ex parte** ALLAN A. JAMES and KENNETH B. ARNOLD

Appeal No. 2004-2031
Application No. 09/733,286

ON BRIEF

Before OWENS, JEFFREY T. SMITH and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

## DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 17-25 and 33-45.

On page 3 of the brief, appellants set forth the grouping on the claims. Accordingly, we consider claims 17, 18, 19, and 24 in this appeal. See 37 CFR § 1.192(c)(7) and (8)(2003).

A copy of claims 17, 18, 19, and 24 are set forth below:

17. A method of improving a molded polyurea polymer's blister resistance, said method comprising:

(A) adding an effective amount of a fatty acid ester to a polyisocyanate and an isocyanate-reactive material to prepare a polyurea-polymer mixture, said fatty-acid ester being jojoba oil; and

(B) molding said mixture to prepare a molded polyurea polymer, wherein said molded mixture is substantially free of blisters and has improved blister resistance, as compared to a molded mixture that is substantially free of jojoba oil, when exposed to moisture and a temperature of at least about 390°F (199°C), said molded polyurea polymer being exposed to said temperature for at least 20 minutes and no longer than 60 minutes.

18. The method of claim 17, wherein said mixture has an isocyanate index between 1.05 and 1.40.

19. The method of claim 17, wherein said mixture further comprises a polyepoxide.

24. The method of claim 17, wherein said molded mixture is substantially free of blisters and has improved blister resistance, as compared to a molded mixture that is substantially free of jojoba oil, when exposed to a temperature of at least about 400°F (204°C).

The examiner relies upon the following references as evidence of unpatentability:

| | | |
|---|---|---|
| Barron et al. (Barron) | 5,525,681 | Jun. 11, 1996 |
| Muenstermann | WO 96/22182 | Jul. 25, 1996 |

Claims 17, 18, 21-25, and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated Muenstermann.

Claims 19, 33, 34, and 36-45 stand rejected under 35 U.S.C. § 103 as patentable over Muenstermann in view of Barron.

## OPINION

I. The anticipation rejection

We consider claims 17, 18 and 24 in this rejection.

We refer to pages 3-5 of the answer regarding the examiner's position in this rejection.

With regard to claim 17, appellants set forth the arguments on pages 4-7 of the brief and appellants set forth additional arguments in the reply brief. Primarily, appellants argue that claim 17 is directed to a method of improving a molded polyurea polymer's blister resistance. Appellants argue that Muenstermann does not disclose that blister resistance may be increased by the presence of jojoba oil in the formulation. Appellants also argue that Tables I and II of their specification demonstrate the unexpected results obtained by the addition of jojoba oil to polyurea. We are not convinced by these arguments for the following reasons.

As pointed out by the examiner on page 4 of the answer, because Muenstermann discloses the same composition as used in appellants' claimed method, the composition inherently possesses the blister resistant characteristics of appellants' claimed composition used in the method of improving blister resistance. Because appellants have not shown that their composition is different from the composition utilized in Muenstermann, we must follow the logic of In re Tomlinson, 363 F.2d 928, 934, 150 USPQ 623, 628 (CCPA 1966), and determine that appellants' process claims are unpatentable by reason of their reading on a process utilizing an old composition. In In re Tomlinson, the claim at issue was directed to a process of inhibiting degradation of polypropylene caused by exposure to light, comprising admixing one of a genus of compounds, including nickel dithiocarbamate, with polypropylene. A reference taught mixing polypropylene

with nickel dithiocarbamete to lower heat degradation. The court held that the claims read on the process of mixing polypropylene with the nickel dithiocarbamate and that the preamble of the claim was merely directed to the result of mixing the two materials. "**While the references do not show a specific recognition of that result, its discovery by appellants is tantamount only to finding a property in the old composition**, not in the nickel compound for which, it is argued, a new use has been found". [emphasis added] Id., 363 F.2d at 934, 150 USPQ at 628. The court ruled the process claims unpatentable by reason of their reading on the admixture of polypropylene and nickel dithiocarbamate, an old mixture.

Applying this same analysis to the present case, we can state that the method of improving blister resistance is merely directed to the result of processing in the claimed manner set forth in claim 17 when utilizing the particularly claimed components.

With regard to Tables 1 and 2, because this rejection is under 35 U.S.C. § 102(b), evidence of unexpected results is of no effect. Appellants' burden is to show that in fact the composition in Muenstermann does not exhibit improved blister resistance.

In view of the above, we affirm the anticipation rejection of claim 17.

With regard to claim 18, appellants state that "Muenstermann does not recite the isocyanate index". However, we refer to page 5 of the answer, wherein the examiner states that the examples of Muenstermann do disclose index values and states the index values are 1.20, 1.10, 1.10 and 1.10, respectively, in the examples, beginning on page 13 of Muenstermann. The examples pointed out by the examiner do show

index values. In the reply brief, appellants do not dispute the examiner's rebuttal in this regard.

Therefore, we also affirm the anticipation rejection of claim 18.

With regard to claim 24, appellants argue on page 7 of the brief, that Muenstermann does not anticipate claim 24 because Muenstermann fails to disclose the ability that when the molded polyurea is exposed to moisture, it takes up no more than 2 weight percent water based on the weight of molded polyurea polymer.

We refer to page 5 of the answer, wherein the examiner states that this characteristic is also deemed an inherent property of the disclosed polyurea set forth in Muenstermann. We agree and refer to our discussion above regarding the burden involved in an inherency rejection, and additionally note that it is well settled that the Patent and Trademark Office can require appellants to prove that a function or property relied upon for novelty is not possessed by prior art otherwise meeting the limitations of the claims. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

In view of the above, we affirm the 35 U.S.C. § 102(b) of claims 17, 18, 21-25, and 35.

II. The 35 U.S.C. § 103 rejection of claims 19, 33, 34, and 36-45

We consider claim 19 in this rejection (on page 3 of the brief, appellants state claims 19, 33, 34, and 36-45 stand or fall together).

We refer to pages 5-7 of the answer regarding the examiner's position in this rejection.

Appellants set forth their arguments regarding this rejection on pages 7-9 of the brief, and also provide additional arguments in the reply brief on pages 2-4.

Claim 19 recites the "method of claim 17 wherein the mixture further comprises a polyepoxide". The examiner relies on Muenstermann in view of Barron for teaching this aspect of claim 19. The examiner refers to the abstract and columns 1 and 2 of Barron, where it is disclosed that polyurea polymers prepared from formulations including a polyepoxide can have good heat stability and good physical properties, and the resultant polyurea polymers can withstand higher temperatures than conventional polyurea polymers without blistering. Hence, the examiner concludes that it would have been obvious to have incorporated a polyepoxide into the composition of Muenstermann in view of the teachings in Barron.

Beginning on page 8 of the brief, appellants argue that the examiner has not provided a proper motivation for combining Muenstermann in view of Barron, and provide reasons therein.

We do not agree, as Barron clearly teaches that polyurea polymers prepared from formulations including a polyepoxide can have good heat stability and good physical properties, and the resultant polyurea polymers can withstand higher temperatures than conventional polyurea polymers without blistering. We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In view of the above, we also affirm the 35 U.S.C. § 103 rejections of claims 19, 33, 34, and 36-45.

III. Conclusion

Each of the rejections is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

TERRY J. OWENS
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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